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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,930	09/11/2003	Wayne E. Cornish	ACS 65357 (1512XCC)	5064

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EXAMINER

ROY, ANURADHA

ART UNIT PAPER NUMBER

3736

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/659,930

Applicant(s)

CORNISH ET AL.

Examiner

Anuradha Roy

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/22/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 64-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 64-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/11/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***DETAILED ACTION***

#### ***Specification***

The abstract of the disclosure is objected to because contains the phase "or the like."

Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: Hodgson et al. (US Patent No. 5,345,945) is listed in the Background of the Invention, but is not listed as a reference in the Information Disclosure Statement. Appropriate correction is required.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 64-71, 75-78, & 82-84 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 7, 10, 15, 16, 20, 22, & 33 of U.S. Patent No. 6,390,993. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent and the claims of the instant application recite similar inventions, where the claims of the instant application are broader, if not synonymous, with the claims of the patent. All of the aforementioned claims recite an elongated member having means for substantially linear change in stiffness including a continuously changing taper angle, a plurality of tapered segments, constant taper angle, material with changing hardness, and a more flexible distal portion. The elements of claims 64, 65, 66, 67, 68, 69, & 70 of the instant application are disclosed in claims 1, 2, 3, 4, 5, 7, & 10 of the patent. The elements of claims 71 of the instant application are disclosed in claim 20 of the patent. The elements of claims 75 and 82 of the instant application are disclosed in claim 33 of the patent. The elements of claims 76 and 83 of the instant application are disclosed in claims 5 and 15 of the patent. The elements of claim 77 and 84 of the instant application are disclosed in claims 6 and 16 of the patent. The elements of claim 78 of the instant application are disclosed in claim 22 of the patent. Since the claims of the patent "anticipate" the claims of the instant application, the claims are not patentably distinct.

Claims 72-74 and 79-81 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20 and 22 of U.S. Patent No. 6,390,993

in view of Eder et al. (US Patent No. 6,488,637). The patent of Cornish et al. discloses a guidewire with at least one longitudinal section having a diameter defined substantially by the formula stated in claim 71 of the instant application (claim 20 in patent) and a moment of inertia defined substantially by the formula stated in claim 78 of the instant application (claim 22 in patent). However, the patent of Cornish et al. does not disclose in the patented claims a core member formed in a group constituting stainless steel, NiTi alloys and combinations thereof, or a proximal and distal section of the core member being coated with a lubricious coating. Eder et al. discloses a guidewire, wherein the core member is formed of one of the group constituting stainless steel, NiTi alloys and combinations thereof (Column 4, lines 32-34 & 55-60). Eder et al. also discloses a core member having a proximal and distal section being coated with a lubricious coating (Column 4, lines 49-51 & Column 7, lines 56-59). It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Eder et al. to use a core member formed of stainless steel, NiTi alloys and combinations thereof with Cornish et al. “to provide a composite guidewire having a stiff [stainless steel] proximal section with exceptional torque-transmitting capabilities and a more distal section with the flexibility and super-elasticity inherent to the super-elastic alloys [Ni-Ti alloy]” (Column 3, lines 56-59). Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Eder et al. to coat the proximal and distal core sections of Cornish et al. with lubricious coating “to enhance its suitability for use within catheters and with the interior of vascular lumen” (Abstract).

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Viera et al. (US Patent No. 5,876,356), Avellanet et al. (US Patent No. 6,019,736), Nguyen (US Patent No. 5,833,631), Colon et al. (US Patent No. 5,402,799), Abele et al. (US Patent No. 5,303,714), Sahatjian et al. (US Patent No. 5,238,004), and Tremulis et al. (US Patent No. 4,953,553) all disclose a guidewire with core member constituting of stainless steel, NiTi alloys and combinations thereof and a lubricious coating of the proximal and distal core members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anuradha Roy whose telephone number is (571) 272-6169 and whose email address is anuradha.roy@uspto.gov. The examiner can normally be reached between 8:00am and 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~AR~

  
MAX F. HINDENBURG  
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